

## REMARKS

In the application claims 1, 2, and 5-19 remain pending. Claims 3 and 4 have been canceled as being drawn to a non-elected species of the invention.

In the Office Action, claims 1-2 and 5-19 were rejected under 35 U.S.C. § 103 as being rendered obvious over Tessier (U.S. Patent No. 5,629,868) in view of Beery (U.S. Patent No. 5,963,269). The reconsideration of this rejection of the claims is respectfully requested.

It is respectfully submitted that a rejection under 35 U.S.C. § 103 requires that the combination of references being relied upon disclose the claimed invention “as a whole.” The requirement that the claimed invention be considered “as a whole” is meant to prevent evaluation of an invention part by part, i.e., breaking an invention into its component parts and then merely finding a reference containing one part, another reference containing another part, etc., and to prevent the impermissible use of the specification of the applicant as a template to combine these parts for the purpose of deprecating the claimed invention. Thus, to assure that such “hindsight reasoning” is not used when assessing the patentability of a claimed invention, a rejection under 35 U.S.C. § 103 also requires a demonstration that an artisan of ordinary skill in the art at the time of the invention, *with no knowledge of the claimed invention*, would have selected the various parts from the references and combined them in the claimed manner.

With this requirement for maintaining an obviousness rejection in mind, it is submitted that neither Tessier nor Berry include any disclosure that can be said to demonstrate that an artisan of ordinary skill in the art would have modified Tessier to arrive at the invention claimed.

Considering Tessier, it is submitted that Tessier fails to disclose, teach, or suggest the desirability of transmitting from a display screen to a remote control, via screen flashes, channel identification information, e.g., information that identifies a currently tuned to channel, as has been espoused in the Office Action. Rather, Tessier discloses the desirability of transmitting from a display screen to a remote control, via screen flashes, control codes for use in controlling a controllable appliance. More particularly, the control codes “define a list of appliances that are controllable as well as their control sequences.” (Col. 2, lines 36-37). Therefore, since it cannot be argued that screen flashes used for the purpose of teaching control codes to a remote control (in a manner similar to a remote control learning such control codes from another remote control) discloses, teaches, or suggests screen flashes used for the purpose of conveying channel identification information, it is submitted that the rejection must be withdrawn.

Considering now Beery, it is similarly submitted that Beery, like Tessier, fails to disclose, teach, or suggest the desirability of using screen flashes to convey channel identification information to a remote control. It is further submitted that that Beery also fails to disclose, teach, or suggest the desirability of using channel identification information conveyed using screen flashes to modify, update, or store channel identification information in a favorite channel table of a remote control. In this regard, while Beery may disclose a system having a favorite channel list, Beery expressly discloses that the favorite channel list is to be populated by a user activating keys of the remote control to designate a channel number (step 378 of Fig. 7) followed by activation of an “enter” key (step 380 of Fig. 7) which functions to store (step 336 of Fig. 7) the designated channel number in memory. Accordingly, if one were to modify Tessier

according to these teachings from Beery, it will be appreciated that one would arrive at nothing more than a system in which the Tessier remote control has a favorite channel list that is populated via a user manually designating channels of interest via actuations of keys of the remote control. Nothing from this disclosure, however, can be said to teach or suggest the desirability of modifying Tessier to use information provided from a source outside of the remote control, e.g., a display using screen flashes to convey such information, to populate a favorite channel table as is claimed. For this reason it is submitted that the rejection must be withdrawn.

#### CONCLUSION

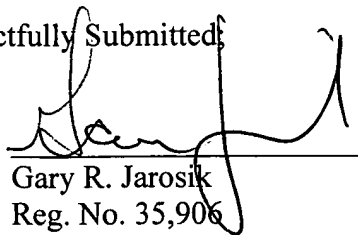
It is respectfully submitted that the application is in good and proper form for allowance. Such action of the part of the Examiner is respectfully requested. Should it be determined, however, that a telephone conference would expedite the prosecution of the subject application, the Examiner is respectfully requested to contact the attorney undersigned.

While it is not believed that any fees are due, the Commissioner is authorized to charge any fee deficiency to deposit account 50-2428 in the name of Greenberg Traurig.

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Respectfully Submitted,

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